

REMARKS

Claims 7 and 9 to 16 are now pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 7 and 9 to 16 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,678,998 ("Muramatsu").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Final Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 7 has been rewritten to better clarify the claimed subject matter consistent with the present specification, including, for example at page 2, lines 22 to 25, and page 3, lines 17 to 18.

Claim 7, as presented, includes the feature of adapting continuously a parameter of a mathematical model of the energy storage mechanism to a real value over the lifetime of the energy storage mechanism; adapting the mathematical model with the adapted parameter; performing extrapolation via the mathematical model; determining at regular intervals the remaining lifetime based on the extrapolation, in which the mathematical model is adapted with the adapted parameter between the regular intervals, and in which the remaining

lifetime is defined as a time until reaching any definable limiting values for one of a minimum efficiency and a minimum storage capacity.

Even if the “Muramatsu” reference did refer to storing predetermined functions representing the relationship between the internal impedance and the remaining capacity and remaining service life of a battery at different frequencies, it does not identically disclose (nor even suggest) the feature of adapting continuously a parameter of a mathematical model nor adapting a mathematical model nor performing extrapolation via a mathematical model, as provided for in the context of the presently claimed subject matter. For example, the functions referred to by the “Muramatsu” reference are predetermined and are not adapted. In contrast, with the presently claimed subject matter, the mathematical model is adapted with a continuously adapted parameter. Thus, the presently claimed subject matter improves upon using predetermined functions by adapting a model of an energy storage mechanism over the lifetime of the energy storage mechanism.

Accordingly, the “Muramatsu” reference does not -- and cannot -- identically disclose (or suggest) the features of claim 7, as presented, so that claim 7 is not anticipated.

For at least the reasons stated above, claim 7 is allowable, as are its dependent claims.

Claim 12, as presented, includes features like those of claim 7, and it is therefore allowable for essentially the same reasons, as are its dependent claims.

In summary, all of pending claims 7 and 9 to 16 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all pending claims 7 and 9 to 16 are in condition for allowance. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
KENYON & KENYON LLP

Dated: _____

11/13/2009

By: _____

Gerard A. Messina
(Reg. No. 35,952)

One Broadway
New York, NY 10004
(212) 425-7200

CUSTOMER NO. 26646

1822892